

REMARKS

Claims 1 through 24 are in the application, with Claims 1, 10 and 16 being independent. Claims 16 through 24 have been withdrawn from consideration. Contrary to the outstanding Office Action, Applicants note that the previous Response distinctly and specifically pointed out the error in the previous Restriction Requirement (i.e. the restricted claims clearly represented a subcombination/combination under M.P.E.P. §806.05(c)II), and therefore the Response should be considered an election with traverse.

Claims 1 through 15 are subject to a new restriction requirement. In particular, the Office Action groups the claims into Claims 1 through 9 (Group I), and Claims 10 through 15 (Group II). In response to the restriction requirement, Applicants provisionally elect Claims 10 through 15. Examination and allowance of the elected claims are respectfully requested. This election is made with traverse for the foregoing reasons.

Restriction is proper only where an application contains claims directed to two or more independent or distinct inventions. As described in M.P.E.P. §806.05(f), the test for determining distinctness of claims directed to a product and to a process for making the product includes two prongs, and the claims may be deemed distinct if either prong is satisfied. The Office Action characterizes the two prongs as follows: “(1) that the process as claimed can be use to make other and materially different product or by hand, or (2) that process as claimed can be made by another or materially different process (sic)”. Applicants note that the second word in prong (2) above should read “product” rather than “process”.

The claimed inventions were deemed to be distinct because the “group I invention could be made by processes materially different from those of the group II invention”. Accordingly, the Office Action seems to rely on prong (2) of the above test. However, the Office Action then notes “for example, in the claim 10 a method for making the device of claim 1 wherein this method can be used to make a single inverter for an analog timer which is a materially different from the device of claim 1 a memory cell or a cache memory”. This example relates to prong (1) of the above test. Since it is unclear which prong is being relied upon, both prongs will be addressed below.

Applicants submit that prong (1) is not satisfied because the Group II process claims describe fabrication of a memory cell and a transistor, and because the Group I product claims describe a transistor and a memory cell as described in the Group II process claims. Since the

claimed process results in the claimed product, the process as claimed clearly cannot be used to make a materially different product. In fact, the “single inverter for an analog timer” made by the Group II process would necessarily include the Group I product, and would therefore not be materially different from the Group I product.

Turning to prong (2), the Office Action does not contain any support for its contention that the Group I product can be made by a process that is materially different from the Group II process. Nevertheless, Applicants submit that any process used to make the product of the Group I claims would necessarily be materially similar to the process of the Group II claims.

The Group I and Group II claims therefore fail to satisfy either prong (1) or prong (2) of the test for determining distinctness. Withdrawal of the outstanding Restriction Requirement is respectfully requested.

CONCLUSION

Applicants hereby request examination of Claims 1 through 15 on the merits. In this regard, Claims 1 through 15 are believed to be in condition for allowance and such action is respectfully requested at the Examiner's earliest convenience.

If there remains any question regarding the present application, or if the Examiner has any suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact the undersigned via telephone at (203) 972-0049.

Respectfully submitted,

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Date



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